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| 09/809,110      | 03/16/2001  | Ryuichi Matsukura    | 1405.1038           | 8919             |

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| EXAMINER |
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FILIPCZYK, MARCIN R

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2163

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/809,110

Applicant(s)

MATSUKURA ET AL.

Examiner

Marc R. Filipczyk

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 March 2001 and 09 March 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This Action is responsive to Applicant's RCE request and Amendment filed March 9, 2007.

To expedite the process of examination Examiner requests that all future correspondences in regard to overcoming prior art rejections or other issues (e.g. amendments, 35 U.S.C. 112, objections and the like) set forth by the Examiner that Applicants provide and link to the most specific page and line numbers of the disclosure where the best support is found (see 35 U.S.C. 132).

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 9, 2007 has been entered. Claims 1-25 are pending.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the **first paragraph** of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed

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invention. Regarding claims 1, 2, 22 and 23 the limitation “additional information user profile related display parameters set by an information provider” and regarding claim 25, the limitation “additional information user profile related display parameters modifiable by an information provider” were not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 3-21 and 24 depend from claims 1 and 2 respectively, and are therefore rejected on the same basis.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the **second paragraph** of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1, 2, 22, 23 and 25, the segment “additional information user profile related display parameters” is indefinite. It is not clear what the metes and bounds of this limitation are. Further regarding claims 1, 2, 22 and 23, the segment “set by an information provider” and with regard to claim 25, the segment “modifiable by an information provider” are indefinite. It is not clear how the provider controls the additional information user profile related display parameters. The rejected limitations are not clearly disclosed in the specification and are

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therefore not clear in the claims. Last, with regard to claim 25, the segment “dynamically changeable” is indefinite. It is not clear how dynamic changing is achieved or controlled.

Regarding claims 3-21 and 24 depend from claims 1 and 2 respectively, and are therefore rejected on the same basis.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-24 are rejected under 35 U.S.C. 102(e) as best as the Examiner is able to ascertain as being anticipated by Handel et al. (U.S. Patent No. 6,195,651).

Regarding claims 1, 2, 5, 7, 8, 14, 22, 23 and 25, Handel discloses a product information system and method comprising (fig. 10A, 1020 and 1070):

additional information management means (fig. 10A, 1020, col. 30 lines 41-55) for storing in an additional information database, additional information (1040) for individual product information (1080) and additional information display parameters (fig. 10A, 1010, 1020) set by an information provider (items 1020 and 1070), to display the additional information for a user (1010, 1080 and 1091), in associating (col. 30, lines 44-45, *link*) with individual product information of a product information database (fig. 10A, 1020 and 1070);

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(Note: via integrator 1020 and supplier's server 1070, the database 1050 links databases 1030, 1040, 1050 and 1060 with supplier databases 1080; see col. 30, lines 43-45)

product information presentation means for presenting basic information for the individual product to a user from the product information database (fig. 10A, 1010, 1020 and 1080);

profile information acquisition means (fig. 10A, item 1020, 1060) for acquiring profile information of the user (fig. 10A, 1010 and 1060) receiving basic information for the individual product (fig. 10A, items 1070 and 1080);

selecting from the additional information database (fig. 10A, 1020, additional information that meets, based upon the acquired user profile information with the stored additional display parameter of the additional information (1030-1060, **1040** and **1060** and col. 30, lines 37-41); and

additional information presentation means for presenting to said user (fig. 10A, 1010) the selected additional information together with the presented basic information of the individual product (fig. 10A, 1010, 1040 and 1080, see also associated text).

*(Note 1: for example, the additional information may be product rating and price)*

*(Note 2: Handel also discloses updating information regarding changes in data by using an awareness machine, see fig. 24, items 2430, 2436, 2446 and 2448, and related text)*

Regarding claims 3, 4, 6 and 9, Handel discloses the profile information acquisition means conducts wireless communication with a user terminal storing that user's profile information to acquire the user's profile information (fig. 17, items 1710, 1730 and 1750).  
(Note: identification of a user is inherent from a user profile)

Regarding claim 10, Handel discloses a product information management server manages a profile database (fig. 10A, 1060 and 1020, and col. 34, lines 35-38).  
(Note: merchants trying to provide a service to the user further imply they manage the profile)

Regarding claim 11, Handel teaches a customer management server (fig 10A, 1020) interconnected with said product information server (fig. 10A, 1070) manages a profile database (fig. 10A, 1060, and col. 34, lines 35-38).  
(Note: the profile gateway server receives all requests for profile information from the user himself)

Regarding claims 12 and 13, Handel discloses product information server (fig. 10A, 1070) manages said additional information database (fig. 10A, 1040).  
(Note: server 1070 manages 1040 along with server 1020)

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Regarding claims 15-19, Handel discloses a java applet for displaying information, accepting text input (col. 8, lines 35-61), and managing text messages (fig. 11, items 1111-1122).

(Note: for more detail also see agents on col. 35 lines 38-61)

Regarding claims 20 and 21, Handel discloses an order procedure accepting product orders from user terminal (fig. 10A, items 1090 and 1010).

Regarding claim 24, Handel discloses the additional information display parameters comprise one or more of age, occupation or user sex (col. 29, lines 23-50), and wherein the additional information is recommendation information (col. 29, lines 36-39).

### ***Response to Arguments***

Applicant's arguments filed on March 9, 2007 have been fully considered but they are not persuasive. The arguments and responses are listed below.

Applicant requests on page 9 approval and entry of corrected replacement sheet for Figure 6.

The submitted Figure 6 has been reviewed and is accepted.

Applicant argues on pages 10-12, that Handel does not teach "additional information user profile related display information parameters" set or modifiable by the information provider.



Examiner disagrees. Referring to fig. 10A, Handel discloses a customer (1010) acquiring basic information from a supplier (1070 and 1080) while a server (1020) uses the customer's profile (1060) along with the supplier's product information (1070 and 1080) and other information (1030 and 1050) to select information for the customer consisting of **additional information for the desired products** (1040 *product ratings*, and 1080, *price and features of each product*) based on the supplier and customer profile databases (1050 and 1060) along with integrator's web server and supplier's web server (1020 and 1070). This additional information is later displayed via the user browser. Further, the user parameters are stored in the customer profile database comprising personal preferences and history (col. 30, lines 41-65). In addition, Database 1080 stores all product related information such as features and pricing and Database 1091 keeps track of all user records for interrelating the products and product information with user profile and history. Last, Examiner notes that the features relied upon by the Applicant are rejected under 35 U.S.C. 112, first paragraph for new matter and 35 U.S.C. 112, second paragraph as indefinite and are rejected as best understood. Applicants have made an effort to cite relevant passages in the disclosure, however, the citations do not teach the amended features. Accordingly, corrections are required.

For more detailed information on Handel, please refer to col. 29, line 13 to col. 30, line 65, and also see rejections above.

With respect to all the pending claims 1-25, Examiner respectfully traverses Applicant's assertion based on the discussion cited above.


***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc R. Filipczyk whose telephone number is (571) 272-4019. The examiner can normally be reached on Mon-Fri, 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571-272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MF  
May 17, 2007

  
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